

Application No. 10/750,402
Response dated December 2, 2005
Reply to Office Action of September 6, 2005

REMARKS

Claims 34-45 and 47-51 are presented for Examiner Chapman's consideration.

Claim 46 was canceled in a previous response.

On page 3 of the office action mailed September 6, 2005, the Examiner states that, "As per Applicants' arguments filed 20 May 2005 at page 16, lines 1-2, ll. 9-12 and ll. 21-22, and per claim 44 which depends from claim 34 Examiner is considering the inner layer of claim 34 to be liquid impermeable." Applicants respectfully disagree with the Examiner's interpretation. The arguments cited by the Examiner were directed only to claim 44 which requires that the elastic inner layer be liquid impermeable. Imparting this limitation to the independent claim is improper. A dependent claim must further limit the independent claim from which it depends. If the elastic inner layer of claim 34 was liquid impermeable, claim 44 would not provide any additional limitation. Therefore, it must be concluded that the proper interpretation of the elastic inner layer of claim 34 is that it may be either liquid permeable OR liquid impermeable.

This interpretation is consistent with the Examiner's remarks on page 2 of the office action in the section titled, "Election/Restrictions," wherein the genus is all elastic inner layers having the stated elements (claim 34). The species are a) liquid impermeable elastic inner layers having the stated elements of claim 34 (claim 44) and b) liquid permeable elastic inner layers having the stated elements of claim 34.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of these remarks and the following responses is respectfully requested.

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Response to Rejections

By way of the Office Action mailed 09/06/2005, claims 34, 35, 38, 39, 40-45, 47 and 51 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,482,191 to Roe *et al.* (Roe) in view of U.S. Patent Number 5,817,086 to Kling (Kling) and further in view of U.S. Patent Number 4,935,021 to Huffman *et al.* (Huffman). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2142, 2143.

The prior art references must teach or suggest all the claim limitations.

As to claim 43, the Examiner states at page 4 that, "Roe discloses the elastic inner layer is elastic in both a longitudinal and lateral direction of the absorbent garment" and cites column 2, lines 46-47 for support. Applicants respectfully disagree with this reading of Roe.

Roe actually states, "The elasticated regions maintain longitudinal and lateral alignment as well as Z-direction proximity with a point of discharge on a wearer." (col. 2, ll. 46-49). This does not state that the inner layer is elastic in both a longitudinal and lateral direction of the absorbent garment. Therefore, all the elements of claim 43 are not disclosed by the combination of references and no *prima facie* case of obviousness has been established. The rejection as to claim 43 should be withdrawn for at least this reason.

There must be a teaching, suggestion or motivation to combine.

As to claim 34, the Examiner acknowledges that "Roe does not expressly disclose the absorbent assembly top sheet layer." To remedy this first defect, the Examiner cites Kling as disclosing an absorbent assembly having a topsheet layer. The Examiner alleges that "it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to form the absorbent assembly of *Roe* having a topsheet layer as taught by *Kling* thereby providing a diaper that **prevents skin irritation.**" (emphasis added).

Additionally, the Examiner admits that the combination of *Roe* and *Kling* "does not expressly disclose the absorbent assembly barrier layer." To remedy this second defect, the Examiner cites *Huffman* as disclosing a fluid impervious barrier layer. The Examiner further alleges that

to form the absorbent assembly of *Roe* and *Kling* having a barrier layer underneath the absorbent assembly as taught by *Huffman* in order to provide a diaper having enhanced breathability thereby **reducing diaper rash and reducing leakage** from the absorbent assembly would have been obvious to one having ordinary skill in the art at the time the invention was made. (emphasis added).

Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine these three references. The Examiner is limited to a conclusory discussion that it would have been obvious to combine the cited references to read on the claimed invention. For example, the Examiner 1) admits that *Roe* fails to expressly disclose the absorbent assembly top sheet layer, 2) finds that *Kling* teaches the use of an absorbent article design that has an absorbent assembly top sheet layer and 3) concludes that it would have been obvious to modify the absorbent article of *Roe* and provide the absorbent assembly with a top sheet layer. Continuing, the Examiner 4) admits that the combination of *Roe* and *Kling* does not expressly disclose the absorbent assembly barrier layer, 5) finds that *Huffman* teaches the use of a fluid impervious barrier layer and 6) concludes that it would have been obvious to modify the combination of *Roe* and *Kling* and provide the barrier layer of *Huffman*.

This reference-by-reference, limitation-by-limitation analysis fails to demonstrate why one skilled in the art would pick and combine these three references. While non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references, *In re Keller*, 642 F.2d 413 (CCPA 1981), the critical inquiry is whether there is something in the references as a whole

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to suggest the desirability, and thus the obviousness, of making the combination, *Lindemann Maschinenfabrik GmbH*, 730 F.2d 1452 (Fed. Cir. 1984).

The motivation to combine cannot derive from Applicants' specification. *See, In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). The Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

There is no indication that one skilled in the art reading *Kling* would be motivated to add the topsheet of *Kling* to *Roe* in an effort to prevent skin irritation. Even assuming, *arguendo*, that *Roe* and *Kling* are properly combined, there is no indication that one skilled in the art reading *Huffman* would be motivated to add a barrier layer underneath the absorbent assembly of *Roe/Kling* in an effort to reduce diaper rash and reduce leakage. The Examiner has not cited any reference that suggests that one skilled in the art possessing the combined teachings of *Roe* and *Kling* would believe that adding the barrier layer of *Huffman* to *Roe/Kling* would successfully reduce diaper rash and/or reduce leakage as alleged by the Examiner. The Examiner has not cited anything to indicate that one skilled in the art would be motivated to move beyond what is already provided by *Roe*'s liquid impervious backsheet 26. This line of reasoning appears to be impermissible post hoc rationalization in an effort to find Applicants' claim elements in three different references.

For at least these reasons, no *prima facie* case of obviousness has been established regarding claim 34 and claims 35, 38, 39, 40-45, 47 and 51 depending therefrom. The rejections as to these claims should be withdrawn.

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By way of the Office Action mailed 09/06/2005, claims 36 and 37 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,482,191 to Roe *et al.* (*Roe*), U.S. Patent Number 5,817,086 to Kling (*Kling*), U.S. Patent Number 4,935,021 to Huffman *et al.* (*Huffman*) and further in view of U.S. Patent Number 4,205,679 to Repke *et al.* (*Repke*). This rejection is respectfully traversed.

The Examiner acknowledges that *Roe* as modified by *Kling* and *Huffman* "is silent on the outer layer". The Examiner looks to *Repke* for the claimed outer layer of claims 36 and 37. However, no *prima facie* case of obviousness has been established because there is no suggestion or motivation to modify the references or combine reference teachings.

The Examiner states that,

In view of the teachings of *Repke*, to form the outer layer of *Roe*, *Kling* and *Huffman* having elastic and extensibility characteristics in order to provide a diaper with enhanced fit and reduced leakage would have been obvious to one of ordinary skill in the art at the time the invention was made since *Repke* states at column 2, ll. 24 to 33 that such a modification enhances the fit of the diaper and prevents liquid strikethrough.

Again, the Examiner has merely recited a purported benefit of *Repke* and concluded that this is adequate motivation to combine a fourth reference to find all the elements of Applicants' claims 36 and 37. While reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention, the Examiner has failed to provide any suggestion or motivation that one skilled in the art would be motivated to combine *Roe*, *Kling*, *Huffman* and *Repke*. The alleged motivations of preventing skin irritation, reducing diaper rash, reducing leakage, enhancing fit and preventing liquid strikethrough are objectives of most absorbent articles. Merely restating the desirability of these objectives does not constitute motivation to combine and therefore does not meet the requisite burden of *prima facie* obviousness. For at least this reason, the rejections as to these claims should be withdrawn.

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By way of the Office Action mailed 09/06/2005, claims 48 and 49 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,482,191 to *Roe et al. (Roe)*, U.S. Patent Number 5,817,086 to *Kling (Kling)*, U.S. Patent Number 4,935,021 to *Huffman et al. (Huffman)* and further in view of U.S. Patent Number 5,269,775 to *Freeland et al. (Freeland)*. This rejection is respectfully traversed.

The Examiner acknowledges that *Roe* as modified by *Kling* and *Huffman* "does not expressly disclose the outer layer length and width greater than the inner layer length and width". The Examiner looks to *Freeland* for the claimed outer layer length and width greater than the inner layer length and width of claims 48 and 49. However, no *prima facie* case of obviousness has been established because there is no suggestion or motivation to modify the references or combine reference teachings.

The Examiner states that,

it would therefore have been obvious to one having ordinary skill in the art at the time the invention was made to form the diaper of *Roe* having an outer layer length and width greater than the inner layer length and width, since *Freeland* states at column 2, ll. 9-15 that such a modification provides a diaper that conforms to the wearer's anatomy thus providing a comfortable diaper for the wearer.

Applicants respectfully disagree with the Examiner's assertion. *Freeland* states that,

a need exists in the art for a topsheet which properly addresses isolation of fecal material from the skin of the wearer and the comfort of the wearer while the disposable absorbent article is worn. Such a topsheet should further address the differences in the wearer's anatomy which are in contact with the topsheet, and the differences such portions of the anatomy have on the effect of the fit of the disposable absorbent article while it is worn and on the cleaning task after the disposable article is removed. (col. 2: ll. 7-16).

One skilled in the art would not be motivated to make this modification because *Roe* already provides for a diaper fitted to the wearer via tensile loading locating the slit opening against the skin near the wearer's anus and maintaining longitudinal and lateral alignment as well as the Z-direction proximity to the anus during the wear cycle. (col. 6: ll. 39-45). Therefore, modifying the diaper of *Roe* to "conform to the wearer's anatomy" would be unnecessary since *Roe* has already provided a diaper "fitted to the wearer."

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Additionally, the suggested modification would change the principle of operation of *Roe*, by substituting the fecal control system taught by *Roe* for the fecal control system taught by *Freeland*. For at least these reasons, one skilled in the art would not be motivated to combine these references and therefore no *prima facie* case of obviousness has been made. The rejection as to these claims should be withdrawn.

By way of the Office Action mailed 09/06/2005, claim 50 stands rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,482,191 to *Roe et al. (Roe)*, U.S. Patent Number 5,817,086 to *Kling (Kling)*, U.S. Patent Number 4,935,021 to *Huffman et al. (Huffman)* and further in view of U.S. Patent Number 5,997,981 to *McCormack et al. (McCormack)*. This rejection is respectfully traversed.

The Examiner acknowledges that *Roe* as modified by *Kling* and *Huffman* "is silent as to the range of percent bonded area to unbonded area". The Examiner looks to *McCormack* for the claimed range of percent bonded area to unbonded area of claim 50. However, no *prima facie* case of obviousness has been established because there is no suggestion or motivation to modify the references or combine reference teachings as discussed above and the prior art references do not teach or suggest all the claim limitations.

The Examiner states that,

In view of these known teachings to bond the inner and outer layers of *Roe* with a percentage of bonded area to the unbonded area of from 10 to 40 as taught by *McCormack* would have been obvious to one having ordinary skill in the art at the time the invention was made in order to meet the requirements of peel strength and refastenability....

Applicants respectfully disagree with the Examiner's assertion. *McCormack* is discussing the bonding area of the outercover laminate, NOT the bonding area between the elastic inner layer and the outer layer as required by claim 50. Therefore, the combination of *Roe*, *Kling*, *Huffman* and *McCormack* do not teach or suggest all the claim limitations and the rejection as to this claim should be withdrawn for at least this reason.

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For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 920-721-3016.

Respectfully submitted,

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